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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,352	07/26/2001	Lawrence A. Denenberg	782.1100	5411

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EXAMINER

GAUTHIER, GERALD

ART UNIT PAPER NUMBER

2645

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,352

Applicant(s)

DENENBERG ET AL.

Examiner

Gerald Gauthier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-64 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/7/05.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on June 7, 2005 was received. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Claim(s) Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claim(s) 1-64** are rejected under 35 U.S.C. 102(e) as being anticipated by Picard et al. (US 6,233,318 B1).

Regarding **claim(s) 1, 48 and 52**, Picard discloses a messaging system (FIG. 1 and column 1, lines 13-19), wherein:

each of a plurality of messages is associated with at least two attributes (FIG. 7 and column 6, lines 35-39); and

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the plurality of messages are enabled to be interactively categorized according to the at least two attributes into overlapping lists of messages by a recipient of the plurality of messages (FIG. 7 and column 6, lines 42-55).

Regarding **claim(s) 2, 7, 14, 19, 53 and 58**, Picard discloses the at least two attributes comprise an urgency indicator and a message received date (column 6, lines 47-55).

Regarding **claim(s) 3, 8, 15, 20, 54 and 59**, Picard discloses the at least two attributes further comprise a message medium indicator (column 6, lines 47-55).

Regarding **claim(s) 4, 9, 16, 21, 55 and 60**, Picard discloses the at least two attributes further comprise a message sender identity indicator (column 6, lines 47-55).

Regarding **claim(s) 5, 10, 11, 17, 22, 23, 56, 61 and 62**, Picard discloses each of the plurality of messages is associated with a status that can represent one of at least three distinct statuses (column 6, lines 47-55).

Regarding **claim(s) 6, 12, 18, 24, 57 and 63**, Picard discloses the at least three distinct statuses comprise "new" "old" and "read" (column 6, lines 47-55).

Regarding **claim(s) 13**, Picard discloses all the limitations of **claim(s) 13** as stated in **claim(s) 1**'s rejection above and furthermore Picard discloses a memory storing a plurality of messages (FIG. 8 and column 17, line 66 to column 18, line 4).

Regarding **claim(s) 25 and 27**, Picard discloses the system can select a list of messages for presentation comprising an intersection of at least two of the overlapping lists (column 6, lines 47-55).

Regarding **claim(s) 26 and 29**, Picard discloses the system selects the list of messages for presentation in response to a user input (column 6, lines 35-55).

Regarding **claim(s) 28**, Picard discloses the intersection is a logical AND or logical OR of the at least two of the overlapping lists (column 6, lines 47-55).

Regarding **claim(s) 30 and 49**, Picard discloses a method of processing a newly-arrived message (FIG. 1 and column 1, lines 13-19), comprising;

receiving the newly-arrived message during a session (FIG. 8 and column 20, lines 56-59); and

presenting the newly-arrived message to a user who is an intended recipient of new arrived message before the user takes action to end the session (FIG. 8 and column 20, lines 2-22).

Regarding **claim(s) 31, 33 and 35**, Picard discloses the newly-arrived message is presented only if the newly-arrived message is urgent (column 6, lines 47-55).

Regarding **claim(s) 32 and 37**, Picard discloses interrupting presentation of a message to present the newly-arrived message (column 20, lines 56-59).

Regarding **claim(s) 34, 38 and 51**, Picard discloses presenting the newly-arrived message before presenting any other message (column 20, lines 56-59).

Regarding **claim(s) 36**, Picard discloses ascertaining, in accordance with:
a command issued by the user during the session, but prior to the receiving the newly-arrived message, and attributes of the newly-arrived message, whether the system would have presented the newly-arrived message earlier in the session if the newly-arrived message had arrived earlier in the session (column 20, lines 56-59).

Regarding **claim(s) 39**, Picard discloses if the newly-arrived message would not have been presented earlier in the session, including the newly-arrived message in a currently-selected set of message to present to the User (column 20, lines 56-59).

Regarding **claim(s) 40 and 50**, Picard discloses the newly-arrived message is presented before the user changes message selection criteria (column 20, lines 56-59).

Regarding **claim(s) 41**, Picard discloses adding the newly-arrived message to a set of messages that are currently selected for presentation (column 20, lines 56-59).

Regarding **claim(s) 42**, Picard discloses all the limitations of **claim(s) 42** in the **claim(s) 30'** s rejection above and furthermore Picard discloses responsive to a user command issued during a session, selecting a set of messages to present to the user, the user being an intended recipient of the newly arrived message (FIG. 8 and column 18, lines 13-42).

Regarding **claim(s) 43**, Picard discloses the newly-arrived message is included in the set of messages to present to the user only if attributes of the newly-arrived message satisfy all selection criteria associated with the user command (column 20, lines 56-59).

Regarding **claim(s) 44 and 46**, Picard discloses at least one of the at least two attributes corresponds to at least one non-user-defined field in an address book (column 18, lines 5-12).

Regarding **claim(s) 45 and 47**, Picard discloses at least one of the at least two attributes corresponds to at least one user-defined field in an address book (column 18, lines 5-12).

Regarding **claim(s) 64**, Picard discloses a method of processing messages (FIG. 1 and column 1, lines 13-19, comprising:

sorting the messages according to multiple attributes thereof, an addressee of the messages having at least partial control over a sort order of the messages (FIG. 7 and column 6, lines 42-46); and

providing the sorted messages to the addressee of the messages (FIG. 7 and column 6, lines 47-62) .

Response to Arguments

4. Applicant's arguments with respect to **claim(s) 1-64** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GERALD GAUTHIER
PATENT EXAMINER

g.g
October 17, 2005


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